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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/540,955	06/27/2005	Ali Mohamed Ali Hassanien	DAVIDK 3.3-011	2506
530 7590 10/30/2007 LERNER, DAVID, LITTENBERG, KRUMHOLZ & MENTLIK 600 SOUTH AVENUE WEST WESTFIELD, NJ 07090			EXAMINER SELKIN, SAUREL J	
			ART UNIT 4153	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/540,955

Applicant(s)

HASSANIEN ET AL.

Examiner

Saurel J. Selkin

Art Unit

3709

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☒ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06/27/2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 06/27/2005.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_.

## DETAILED ACTION

### *Drawings*

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the examiner requests drawings showing a perspective view of all three (3) cylindrical parts for a better understanding of the invention. It is not clear how the cylinders interconnect. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Specification***

2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The “distilled water” referred to in claim 10 is not disclosed in the specification.

3. The disclosure is objected to because of the following informalities: spelling and grammatical errors throughout disclosure.

Appropriate correction is required.

***Claim Objections***

4. Claims 2, 3, 9, 11 and 12 are objected to because of the following informalities: spelling errors.

In claim 2, line 4 “is should be changed to --are--.

In claim 3, line 3 “circumscription” should be changed to --circumscriptive--.

In claim 9, line 3 “rleased” should be changed to --released--.

In claim 11, line 3 “syreinge” should be changed to --a syringe--.

In claim 12, line2 “reference” should be changed to --reference--.

Appropriate correction is required.

5. Applicant is advised that should claim 5 be found allowable, claim 6 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both

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cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim.

See MPEP § 706.03(k).

6. Claim 11 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 11 seeks to further limit claim 10 by defining the pressure source. There is no pressure source mentioned in claim 10.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 2, 5, 7 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2 recites the limitations "'the first part'" in line 2 and "the three grooves" in line 8. There is insufficient antecedent basis for this limitation in the claim.

Claim 5 recites the limitation "the second part" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 7 recites the limitation "pressure source" in line 6. There is insufficient antecedent basis for this limitation in the claim.

Claim 11 recites the limitation "the pressure source" in line 3. There is insufficient antecedent basis for this limitation in the claim. The term "can be" used in the claim to describe the "pressure source" is a relative term which renders the claim indefinite. The specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably appraised of the scope of the invention.

8. Claims 2, 3, 5 and 7 are rejected as failing to define the invention in the manner required by 35 U.S.C. 112, second paragraph.

The claim(s) are narrative in form and replete with indefinite and functional or operational language. The structure which goes to make up the device must be clearly and positively specified. The structure must be organized and correlated in such a manner as to present a complete operative device. The claim(s) must be in one sentence form only. Note the format of the claims in the patent(s) cited.

9. Claim 12 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite in that it fails to point out what is included or excluded by the claim language. This claim is an omnibus type claim.

***Claim Rejections - 35 USC § 101***

***Double Patenting***

10. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

11. Claims 1-11 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-11 of copending Application No. 11/269210. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 1, 9 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Hosoda (US 5569268) henceforth referred to as Hosoda. Hosoda discloses an instrument for ligating varices consisting of three cylindrical parts (fig. 7) capable of

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being loaded with multiple ligating bands (col. 11 lines 32 and 33) capable of releasing 1 band at a time (col. 11 lines 40-43)

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 2 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hosoda in view of Suzuki et al (US 6464685), henceforth referred to as Suzuki, and further in view of Chu et al (US 5697940) henceforth referred to as Chu. Hosoda (fig. 7), Suzuki (fig. 1B) and Chu (fig.2) disclose ligation devices with a cylinder threaded in the lower part and not threaded at the top. They also disclose "grooves" in the threaded areas of their device. The unthreaded part of their device is also covered by another cylinder bigger in diameter than the threaded cylinder. Any other difference between those devices and the instant device, such as the length of the second cylinder, is obviously a matter of design choice as there is no indication in the disclosure of any effect of those differences on the performance of the device.

Concerning claim 4, Hosoda (fig. 7), Suzuki (fig. 1B) and Chu (fig. 2) also discloses "grooves" in the threaded areas of their device which serve as passageways. Any difference between those devices and the instant device, such as the number of



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passageways, is obviously a matter of design choice as the only purpose of the passageway is to allow "tongues" to pass through.

14. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hosoda in view of Chu. Both Hosoda (fig. 7) and Chu (fig. 2) disclose ligation devices having threads which are circumscriptive and in which the dimensions of the threads and the distances between them are identical. The cross section of the threads of the device disclosed in Chu et al is triangular and the altitude of the triangle is upwardly positioned. Hosoda also discloses threads having a similar cross sectional profile (fig. 1) on an outer cylinder of his device. The choice of such a cross sectional profile for the threads of the device is, then, an obvious matter of design choice.

15. Claims 5, 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hosoda in view of Suzuki. Hosoda (fig.7) and Suzuki (fig. 5) disclose ligation devices which include an unthreaded base cylinder having threaded arms emerging therefrom. The thread in the arms of the device in the Suzuki disclosure are identical in all aspects with the threads in another cylindrical part of the device. Hosoda also discloses a spring in his device for the purpose of moving the arms back and fourth within the device. The number of arms used in the design of those devices is clearly an obviously a matter of choice as the number of arms in ligation devices in the art varies from one device to another.

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Concerning claim 7, Hosoda (fig. 7) discloses a ligation device consisting of three cylinders. Suzuki (fig. 2A) discloses a tube connected to the space between the outer and inner cylinder that is connected to a pressure source outside of the device. Any difference between those devices and the instant device is obviously a matter of design choice.

16. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki et al (US 6464685). Suzuki discloses the use of water to release the ligating device from the ligating instrument (col.1 lines 60-63). The use of air as an alternate fluid to release the ligation instrument is an obvious variation as the use of air pressure to eject, loosen or release objects is common knowledge.

17. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki and Middleman et al (US 5749879). Suzuki discloses the use of a fluid to release the ligating band from a ligating device (col. 1 lines 60-63). Middleman (col. 27 lines 2-4) discloses the use of a syringe to activate ligation systems in general. Both disclosures are directed to ligation devices and the release of ligation bands from said devices. Both were published prior to the time of filing of this application. It would have been obvious to anyone having basic knowledge in the art at the time of this invention to modify Suzuki using Middleman's teaching in choosing a release method of bands from a ligation device

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**Conclusion**

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US 5100418, US 5445167, US 5788715, US 5906625, US 6491707, US 6547798, US-2005/0149067 and US 7189247.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Saurel J. Selkin whose telephone number is (571) 270-3813. The examiner can normally be reached on Monday-Thursday 8:00 a.m.- 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Jackson can be reached on (571) 272-4697. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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10/18/07

GARY JACKSON  
SUPERVISORY PATENT EXAMINER

